



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,376	07/24/2003	Robert S. Greff	7267.57226-A-RE	2506
20311	7590	11/20/2009	EXAMINER	
LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			LAVENDER, JACK W	
ART UNIT	PAPER NUMBER	3677		
NOTIFICATION DATE		DELIVERY MODE		
11/20/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmipilaw.com

Office Action Summary	Application No. 10/626,376	Applicant(s) GREEFF, ROBERT S.
	Examiner Jack W. Lavinder	Art Unit 3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 October 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-23 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

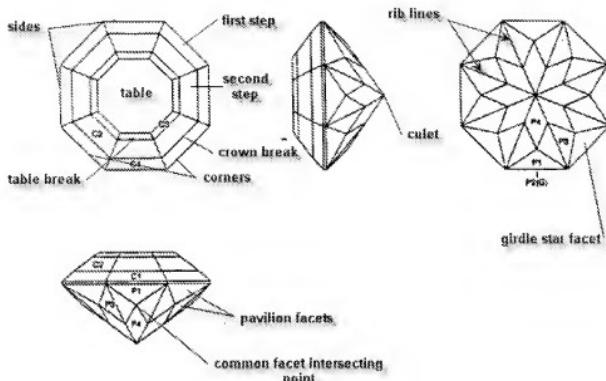
DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

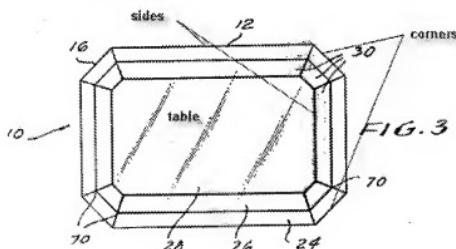
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the non-patent literature, Gram Faceting Designs (GFD) in view of Grossbard, 4020649. GFD discloses a mixed cut diamond (step cut on the crown and brilliant cut on the pavilion. GFD's stone is octagonal in shape with corner crown lengths equal to corner side lengths and four table corner lengths equal to four table side lengths. The pavilion has a culet point with eight rib lines extending in a straight line from the girdle to the culet. The crown also comprises at least two steps with a flat table (see annotated figure). The number and shape of the facets on the pavilion as defined in the claims are shown in GFD.



The claims recite that the corner lengths of the crown and table are substantially less than the side lengths of the crown and table. GFD discloses the lengths to be the same.

Grossbard, 4020649, discloses a mixed-cut gemstone having corner lengths less than the side lengths of the table and crown.



The applicant's change in the shape of the stone is considered to be for ornamental purposes only, i.e., nothing unexpected in the fire, scintillation, brilliance or dispersion in the gemstone was achieved by the change in shape of the gemstone. Therefore, it would have been an obvious design choice to make GFD's stone into the shape of Grossbard's stone in order to change the aesthetical appearance of the stone.

Response to Arguments

Applicant's arguments filed 10/20/2009 have been fully considered but they are not persuasive.

The declarations under 37 CFR 1.132 filed 10/20/2009 are insufficient to overcome the rejection of claims 1-23 based upon Gram Faceting Designs in view of Grossbard, 4020649. The declarant opines that "if a gemstone designer was seeking to improve the dispersion, brilliance or scintillation, or even yield, they would not have arrived or be motivated to provide the subject gemstone design I conceived....I believe that my design objectives were a significant departure from the objectives that gemstone designers normally try to achieve..." This has not been found to be persuasive in overcoming the applicant's burden of proving that the novelty of their invention is merely a change in shape of the gemstone without any unexpected results such as unforeseen increase the amount of fire, scintillation, brilliance or dispersion. The prior art in combination discloses all the elements of applicants claimed invention. One would be motivated to combine the two different stones to create a different aesthetically pleasing stone in order to sell more gemstones. However, in order for the claimed new shape of the gemstone to be patentable, there must be some unexpected

result, such as fire, brilliance, scintillation or dispersion, which can be shown and proven scientifically by comparing these properties between the new gemstone and the prior art gemstones.

The applicant has the burden to prove that their stone is producing an unexpected brilliance, fire, dispersion, and scintillation due to the shape, number, orientation and size of the facets being claimed. It is agreed that the facets on a gemstone perform the function of changing the incidence light and redirecting the light to produce the fire, scintillation, brilliance and dispersion of the gemstone. However, this has been known, done and achieved by the prior art. In order to consider that the change in shape of the gemstone is patentable, the applicant must provide scientific proof that an unexpected increase in brilliance, fire, scintillation or dispersion of the gemstone was achieved by the specific shape, number or orientation of the facets on the gemstone. This is not a new requirement in showing novelty. If the newly claimed device only changes the shape of the device, an unexpected result must be achieved in order for that change-in-shape to be considered patentable subject matter. In this application, the applicant has only changed the shape of the facets and their orientations on the gemstone and nothing more than a novel aesthetical shape of gemstone has been achieved.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571-272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jack W Lavinder/
Primary Examiner, Art Unit 3677